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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,904	04/14/2006	Keitaro Yonezawa	YONE3024/JC/PMB	5549
23364 7590 08/06/2008 BACON & THOMAS, PLLC 625 SLATERS LANE FOURTH FLOOR ALEXANDRIA, VA 22314-1176			EXAMINER WATSON, ROBERT C	
			ART UNIT	PAPER NUMBER
			3723	
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			08/06/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/575,904

Applicant(s)

YONEZAWA ET AL.

Examiner

Robert C. Watson

Art Unit

3723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 7-11 and 17-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-3, 7-11 and 17-19 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "opposed direction" and the "direction orthogonal to the opposed direction" of claim 1 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claims 1-3, 7-11, and 17-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 6 "orthogonal to the opposed direction" is not understood.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 7, 9, 11 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yonezawa ('374) in view of Obrecht.

Yonezawa shows a positioning apparatus in Figure 3 having a first pressing member 15, and opposed second pressing members 18 inside the first pressing member, and a drive arrangement 22. In Yonezawa slide portions 13 arranged around the plug member 9 and opposed to each other across the plug member in an opposed direction. To make these slide portions radially expandable would have been more than a duplication of the teachings of first press member 15 in Yonezawa which is taught as being radially expandable (see column 3, [47] of Yonezawa). One skilled in the art would have been motivated to do this to enhance clamping.

Obrecht shows a second pressing member 20 in the shape of a wedge that is mounted on a slide member 30 such that the first pressing member 20 in addition to moving in the direction of the drive member 70a may also move orthogonal to this direction (ie., in the direction of in and out of the page in Figure 4).

To shape the second pressing member of Yonezawa in the shape of a wedge and to suitable shape the sliding walls in a fashion to accommodate the wedges to produce expanding movement would have been obvious in view of the teachings of Obrecht. One skilled in the art would have been motivated to do this to simplify the construction of the pressing member arrangement. To additionally provide a slide member for the second pressing member such that orthogonal movement would be permitted for the wedge shaped slide member would have been obvious in view of the teachings of Obrecht. One skilled in the art would have been motivated to do this in order to enhance self alignment and prevent misalignment and, in general, to provide an additional degree of movement for adjustment which per se is well known and obvious. To employ more than one position member is no more than an obvious duplication of the teachings of Yonezawa.

Claims 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yonezawa ('374) in view of Obrecht in view of Haruna ('738).

The first pressing member 15 of Yonezawa is radially expandable and contractible by means of it being made of a resilient material.

Haruna teaches that the pressing member 23 is made radially exapandable and contractable by means of employing a slit in its annular shape. To made the first pressing member of annular shape with a slit in Yonezawa would have been obvious in view of the Haruna disclosure. One skilled in the art would have been motivated to do this in order to simplify the construction of the radially contractable and exapandable sleeve. To further make the second pressing member radially expandable and

contractable utilizing a slit in an annular member would be no more than a duplication of the Haruna teachings.

Applicant's remarks have been given careful consideration. In particular applicant states that that in Yonezawa there are no slide portions arranged around the plug portion and opposed to each other across the plug member. Applicant has apparently overlooked in Yonezawa slide portions 13 arranged around the plug member 9 and opposed to each other across the plug member in an opposed direction. To make these slide portions radially expandable would have been more than a duplication of the teachings of first press member 15 in Yonezawa which is taught as being radially expandable (see column 3, [47] of Yonezawa). One skilled in the art would have been motivated to do this to enhance clamping. Applicant's statement that the second pressing member 15 of Yonezawa flies does not move radially flies in the face of column 3, [47] of Yonezawa where it is disclosed that the second pressing member elastically deforms radially outwards and returns radially inwards. To make any structure in and across the plug member expand radially outward or inward is found to be an obvious duplication of the teachings of radially expandable pressing member 15 of Yonezawa. Applicant's statement that the substitution of wedges with the suitably inclined surfaces to achieve expansion for the balls with their respective inclined surfaces is found to be untenable. Merely substitution one form of expansion for another would not make the Yonezawa device inoperable. At, least if on one skilled in the art make the substitution one skilled in the art would not make the substitution in an improper way and cause it to become inoperative; ie., one skilled in the art would

know how to make the substitution such that inoperativeness does not result. To substitute one form of expansion for another and to use radially expandable materials where desired is well know and obvious as demonstrated by the references as applied. Although applicant obviated one layer of indefiniteness wrt to the "slide portions" in the last paragraph of claim 1, other indefiniteness wrt to those same slide portions still remains and the 35 USC 112 second paragraph rejection continues.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert C. Watson whose telephone number is 571 272-4498. The examiner can normally be reached on Mon. - Thurs. , 5:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph J. Hail III can be reached on 571 272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3723

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert C. Watson/

Primary Examiner, Art Unit 3723

rcw